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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,450	06/28/2001	Naoto Arakawa	35.C15502	2135

5514	7590	01/13/2006

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EXAMINER
POON, KING Y

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/892,450	ARAKAWA, NAOTO
	Examiner	**Art Unit**	
	King Y. Poon	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 October 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-36</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-20 and 29-31</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>21-28 and 32-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 June 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20, 29-31 are withdrawn from further consideration pursuant to 37 CFR

1.142(b), as being drawn to a nonelected invention, there being no allowable generic or

linking claim. Applicant timely traversed the restriction (election) requirement in the reply

filed on 0/19/2005.

2.   Applicant's election with traverse of the restriction requirement in the reply filed

on 10/19/2005 is acknowledged. The traversal is on the ground(s) that the search for

the three inventions are the same. This is not found persuasive because it was shown

a serious burden on the examiner by classifying the different inventions in different

subclass and showing separate status in the art. The examiner agrees that there may

perhaps be some related subject manner; however, there is greater amount of

searching required in areas that are not related.

The requirement is still deemed proper and is therefore made FINAL.

3.   This application contains claims 1-20, 29-31 drawn to an invention nonelected

with traverse in Paper filed on 10/19/2005. A complete reply to the final rejection must

include cancellation of nonelected claims or other appropriate action (37 CFR 1.144)

See MPEP § 821.01.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 21-28, 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepin et al (US 6,151,131).

Regarding claims 21, 27: Pepin teaches a controlling apparatus (4 and 7, fig. 2) comprising an input unit (4, fig. 2) adapted to input data from a remote (remote, column 5, line 47) information processing apparatus (remote source, column 5, lines 63-67, fig. 7) which can selectively send data of a series of original (PDL, column 6,lines 1-5) including at least both of a specific page including a command (delayed instruction in one or more sheet of a print job, column 11, lines 15-20 and placeholder page, column 9, lines 64-67) for causing a printer apparatus (the whole apparatus of fig. 2) to perform a specific processing and a page where the command is not included (other pages that are not the placeholder page, column 10, lines 1-15) and data of a series of originals where the specific page is not included (no to 228, fig. 9, document that has no placeholders) and a controller (7, fig. 2) adapted to cause the printer apparatus to perform a printing process of input originals data from the remote information processing apparatus, wherein said controller causes the printer apparatus to perform the printing process of the data and causes the printer apparatus to perform the specific processing in case that the data input by said input unit is the data of the series of originals including at least both of the specific page including the command for causing

the printer apparatus to perform the specific processing (e.g., obtaining an image from a remote location and integrated at a location designated by a placeholder, column 12, lines 15-40) and the page where the command is not included, and wherein said controller causes the printer apparatus to perform the printing process of the data without executing the specific processing in case that the data input by said input unit is the data of the series of originals where the specific page is not included (if the delay instruction is not included, the printing apparatus would not process the delay instruction because there are no delay instructions to be processed).

Regarding claims 22, 32: Pepin et al. teach an apparatus according to claim 21, wherein said controller causes the printer apparatus not to print the page to which the information indicating the instruction for the printer apparatus is added (fig 9, steps 228 and 230, & column 10 lines 58-65, when processing placeholders and delay instruction, the function of the placeholder, i.e. retrieval of the page to be added, is resolved, which prevents the printer from printing the instruction of the page).

Regarding claims 23, 33: Pepin et al. teach an apparatus according to claim 22, wherein said controller executes processing aimed for generating data, of which state is that an instruction added page in the original data input from the information processing apparatus is exchanged to a page of the original data from a scanner unit, as one document (column 10, lines 9-17, jobs are programmed on a segment-by-segment basis, wherein, column l0, lines 55-65, a segment containing a place holder is resolved, i.e. the retrieval of the document to replace the instruction is executed, and, column

11:lines 3-5, the entire job is stored or output for printing. Column 8, lines 25-32,

placeholder data can be from scanner 6, or a remote scanner, column 12, lines 40-45).

Regarding claims 24, 34: Pepin et al. teach an apparatus according to claim 23,

wherein said controller prints data obtained by performing an exchange between the

instruction added page in the original data input from the information processing

apparatus and the page of the original data from the scanner unit as one document

(column 11, lines 3-5, the entire job is stored or output for printing. Column 8, lines 25-

32, column 12, lines 40-45, placeholder data can be from scanner. Column 6, lines 64-

67, printer prints in accordance with parameters from control means 7).

Regarding claims 25, 35: Pepin et al. teach an apparatus according to claim 23,

wherein said controller stores data obtained by performing an exchange between the

instruction added page in the original data input from the information processing

apparatus and the page of the original data from the scanner unit into storage means as

one document (column 11:lines 3-5, the entire job is stored or output for printing after

segment-by-segment processing for placeholders and non-placeholders. Column 8:lines

25-32, column 12, lines 40-45, placeholder data can be from scanner).

Regarding claims 26, 36: Pepin et al. teach an apparatus according to claim 22,

wherein the image formation apparatus has storage means (fig 2, main memory 56) for

previously storing sheets on which images were formed (column 7:lines 33-37, main

memory 56 stores sheets being processed), and said controller causes the image

formation apparatus to print the pages other than the page, to which the information

indicating the instruction for the image formation apparatus is added, included in the

data of a series of the originals and the sheets on which images were formed are

previously fed from said storage means in accordance with a fact that the page judged

to exist in the input data of the series of originals is the page to which the information

indicating the instruction for the image formation apparatus is added, then processing

for inserting the fed sheet among sheets, on which images of the pages other than the

page to which the information indicating the instruction is added are formed, is executed

on the basis of the instruction (column 8:lines 25-32, print jobs may be derived from

multiple sources, i.e. previously stored documents and insert originals. Column 9:lines

64-67, placeholder pages indicate pages to be added in a submitted printer job. In this

case, the placeholder and delay instructions indicates that the sheets in the storage

means will be combined with the series of originals at placeholder indicators. Column

10:line 66 - column 11:line 5, each segment, in this case the segments for originals and

for stored sheets, is processed and formed to one print job for printing or storage).

Regarding claim 28: Pepin teaches a computer readable storage medium which

stores program for the method and apparatus disclosed in claims 21, 27 (column 7,

lines 34-36).

Response to Arguments

6.   Applicant's arguments filed 6/23/2005 have been fully considered but they are

not persuasive.

With respect to applicant's argument that Pepin does not teach an input unit adapted to input data from a remote information processing apparatus, has been considered.

In reply: Column 5, lines 62-67, teaches an input unit adapted to input data from a remote site. Fig. 7, column 8, lines 25-65 teaches the remote site would be a PC, column 8, line 49 or a Xerox 6085 workstation, column 8, line 61, i.e., a remote information processing apparatus.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to King Y. Poon whose telephone number is 571-272-

7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on 571-272-7437. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

January 6, 2006

KING Y. POON
PRIMARY EXAMINER